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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,042	06/28/2001	Dane R. Jackson	460.2125USU	5504

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,042

Applicant(s)

JACKSON ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 9-14, 16-20, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 3, 8, 15 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicant's amendment of 4-22-02 has been entered. The examiner will address applicant's remarks at the end of this office action. Currently claims 1-5,7-23 are pending.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 18 the examiner is confused as to how applicant can recite that the gripping structure is "other than a rib" but at the same time recites "grooves" and "louvers" which would inherently result in ribs being present. The embodiment of louvers would have ribs and the louvers would each define a rib. If you had grooves the area between the grooves could be considered a rib. The scope of this claim is not clear because the claim seems to exclude ribs but recites structure that has ribs. This claim is considered indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,4-5,9-14,16-18,19,20,22-23. are rejected under 35 U.S.C. 102(b) as being anticipated by Lichstein et al. (4536178).

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With respect to claims 1,2,9-12, Lichstein discloses a barrel 16 that has a fingergrip area 32. The fingergrip area has two flattened surfaces 30. The gripping structure is considered to be the concavity or depression that is disclosed in column 4, lines 14-24.

With respect to claims 4,5 (as best understood by the examiner), the 2 angles surfaces are 34.

With respect to claims 13,14,16,17 (as best understood), Lichstein discloses a barrel 16 with a gripping area 32. The gripping area has two convex surfaces which are the portions of 32 that are convex (between the flat surfaces 30). The gripping structure is considered to be the flat surfaces 30 themselves along with angles shoulders 34. The surfaces 30 and 34 are not a rib.

With respect to claim 18, surfaces 30 and 34 define a groove or even an embossment with respect to the remainder of the barrel.

With respect to claims 19,20,22,23 (as best understood), Lichstein discloses a barrel 16 with a gripping area 32. The gripping area has two concave surfaces which are considered to be the depressions that are disclosed in column 4, lines 14-24. The gripping structure is considered to be the flat surfaces 30 themselves along with angles shoulders 34. The surfaces 30 and 34 are not a rib. The surfaces 30 and 34 define a groove or even an embossment with respect to the remainder of the barrel.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1,7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichstein et al. in view of Voss (3575169).

Lichstein discloses a barrel 16 that has a fingergrip area 32. The fingergrip area has two flattened surfaces 30. Lichstein discloses a gripping structure in the form of ribs (raised above the surface as claimed). Lichstein does not disclose the fingergrip area as being other than ribs. Voss discloses numerous fingergrip aids that will aid the user when using the applicator. Voss discloses that a highly abrasive outer surface is desirable and discloses a gripping aid in the form of a plurality of abrasive particles adhered to the outer surface of the rear end of the barrel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Lichstein with highly abrasive particles for a gripping structure as disclosed by Voss so that the gripping structure could provide maximum grip to the user.

Allowable Subject Matter

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8. Claims 3,8,15,21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's arguments filed 4-22-02 have been fully considered but they are not persuasive.

With respect to the traversal of the 112,2nd paragraph rejection of claims 18,24, the examiner finds the arguments non-persuasive. The examiner does not agree with applicant's definition or interpretation of the language in question. The term "rib" is used to define the slat like pieces of a wing for an airplane (that are inside the wing). The individual ribs are simply pieces of material that extends from the spar of the wing to the leading and trailing edges of the wing. Applicant's definition of, or argument, that a rib is only an elongated ridge (raised above the surface of the article) is non-persuasive. Webster's Ninth New Collegiate Dictionary even says a rib can be "one of the stiff strips supporting an umbrellas fabric". Applicant's counsel has cited the 3rd listed definition for the term "rib" and seems to exclude the other definitions from the scope of the term "rib", without explanation. The term "rib" is broader than what has been argued. In the examples of louvers, each individual slat like piece can be considered a rib, just like in a wing structure or a boat (a rib member that extends from keel to deck). With respect to the argument concerning whether or not a groove can define a rib, the examiner disagrees with applicant's selective interpretation of this term. If you have grooves in a surface of an article, the area between the grooves can be considered as a rib. Applicant seems to argue that a rib is "a raised round elongated

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ridge". What does a rib have to be round? Where does that come from? Why can't a rib be defined as the material between two grooves? The rib is raised with respect to the low point of the grooves and is elongated in form or shape, so why is it improper to call this structure (created by material between grooves) a rib? The arguments are found to be non-persuasive.

With respect to the traversal of the 102 rejection, the examiner will address each argument for each claim argued by applicant.

With respect to claim 1, applicant has argued that the concavity or depression disclosed in column 4, lines 14-24 cannot be called a gripping structure. Why not? This structure is disclosed as being configured to complement the curvature of a user's finger so the examiner takes the position that this can be called a gripping structure. The structure conforms to the finger of a user so it clearly does aid in gripping. The concavity or depression can be considered as an embossment. Applicant appears to be arguing what Lichstein discloses and calls the gripping structure as opposed to what the examiner has identified the gripping structure to be.

With respect to claim 9, the term "aligned" is very broad and can mean almost anything. The argument presented for patentability does not say anything other than the prior art does not disclose "aligned" so the examiner cannot offer any other comment other than that the argument is found to be non-persuasive. The prior art discloses what is claimed.

With respect to claim 13, applicant has argued that Lichstein does not disclose "convex gripping areas"; however, the claim does not require such. The claim recites "a

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fingergrasp area" that has "at least one convex surface", not a convex gripping area as argued. The examiner is not going to read into the claims structure disclosed but not claimed. The prior art has a fingergrasp area that has a convex surface as claimed.

With respect to claim 14, applicant has relied upon the argument for claim 13 so there is no real argument that points out why claim 14 is patentable. The argument for claim 13 is found to be non-persuasive so the argument for 14 is also non-persuasive.

With respect to claim 18, the argument does not clearly point out what is considered novel. Stating what surfaces 34 of the present invention are supposed to be as far as what is disclosed is non-persuasive. The examiner is not going to read into the claims structure disclosed in the application but not claimed. The claim is broader than what applicant apparently intends it scope to be. Also, what does the claimed subject matter of claim 16 have to do with claim 18? Claim 18 depends to claim 13, not claim 16. The argument is non-persuasive.

With respect to claim 19, as stated previously, applicant is arguing the disclosed invention as opposed to what is claimed. The examiner is not going to read into the claims, structure disclosed in the application but not claimed. The surfaces as explained by the examiner are fully capable of being gripped. The claim is broader than what applicant apparently intends it scope to be. The argument is non-persuasive.

With respect to the traversal of the 103 rejection of claims 1 and 7, the argument does not really address the combination as set forth by the examiner. The combination results in an applicator with a gripping structure that is a high wet coefficient of friction material. The abrasive material of Voss clearly can be called a high coefficient of

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friction material, which is a member of the Markush grouping of claim 1. The argument is non-persuasive.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


DENNIS RUHL
PRIMARY EXAMINER